

DOCKET NO: 213287US6X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

JEAN-MARIE STAWIKOWSKI, ET AL. : EXAMINER: ZHONG, C.

SERIAL NO: 09/940,462 :

FILED: AUGUST 29, 2001 : GROUP ART UNIT: 2152

FOR: COMMUNICATION SYSTEM OF :
AN AUTOMATION EQUIPMENT BASED
ON THE SOAP PROTOCOL

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant respectfully requests that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A CASE OF ANTICIPATION

Applicant submits that the Official Action of October 14, 2005 has failed to provide a case of anticipation with respect to any of Claims 1-11 or 13-20 under 35 U.S.C. §102 or a *prima face* case of obviousness with respect to Claim 12 under 35 U.S.C. §103.¹

Pending independent Claims 1, 18, and 19 stand rejected under 35 U.S.C. §102 as anticipated by Linderman. However, as detailed in the responses filed September 9, 2005 and January 17, 2006, application of the Linderman reference in this anticipation rejection is improper. Accordingly, only the disclosure of U.S. Provisional Application No. 60/208,045

¹See Official Action of October 14, 2005 detailing the rejection of Claims 1-11 and 13-20 under 35 U.S.C. §102(e) as anticipated by Linderman (U.S. Patent Publication No. 2002/0032790, hereinafter "Linderman") and the rejection of Claim 12 under 35 U.S.C. §103(a) as unpatentable over Linderman in view of 'Frequently Asked Questions about XML', (Microsoft, June 2000).

(P '045) will be treated herein. As further outlined in detail in the responses filed September 9, 2005 and January 17, 2006, this rejection is deficient in that P '045 fails to provide any discussion relative to an entire element of the Applicants' claims.

Independent Claim 1 recites, *inter alia*, "at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network."

The outstanding Office Action conceded at page 6, lines 19-20 that P '045 does not teach the T-box 32 of Linderman. The outstanding Office Action then alleges that "the provisional application '045 teaches the concept of the T-box and its equivalent functionalities."² The response filed January 17, 2006 pointed out that the description of "a concept" does not provide the level of detail recited in Claim 1, which is contrary to well settled case law which requires that "the identical invention must be shown *in as complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added). See also MPEP §2131.

The response filed further noted that the description of "a concept" also does not provide an enabling disclosure of the invention recited in Claim 1. This is also in conflict with well settled case law which requires that the disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter. *Mere naming or description of the subject matter is insufficient*, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). (Emphasis added.) See also MPEP §2121.01.

²See the outstanding Office Action at page 7, lines 8-9.

In response, the Advisory Action dated February 2, 2006 cites the present specification for enabling details of the invention recited in Claim 1.³ ***"In light of Applicant's specification,*** Linderman teaches the concept of a 'web service' because DaberNet software has a client side and a server side module."⁴ Again, in accordance with the above cited case law, description of "a concept" does not teach any element of the present invention. Further, the need to cite to the present specification to support the rejection, rather than the reference itself, shows the present rejection is a hindsight rejection based on the present specification rather than P '045.

The Advisory Action further states "In response to Applicant's arguments, client server side remote procedure calls and SNMP protocols are well known to the person of ordinary skill in the art at the time the invention was made."⁵ No evidence whatsoever is provided to support this naked assertion. Again, the present rejection's reliance on unspecified external evidence clearly shows that P '045 does not teach each and every element of Claim 1 and does not enable the invention recited in Claim 1.

Consequently, as P '045 is not an enabling disclosure and P '045 does not teach each and every element of Claim 1, Claim 1 (and Claims 2-11 and 13-17 dependent therefrom) is not anticipated by P '045 and is patentable thereover.

Independent Claims 18 and 19 recite similar elements to Claim 1, albeit in process form. Accordingly, Claims 18 and 19 (and Claim 20 dependent therefrom) is believed to be patentable over P '045 for at least the reasons described above with respect to Claim 1.

With regard to the rejection of Claim 12 as unpatentable over P '045 in view of 'Frequently Asked Questions about XML,' it is noted that Claim 12 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above with respect to

³See Advisory Action dated February 2, 2006, page 2, lines 2-3 (Emphasis added).

⁴Advisory Action dated February 2, 2006, page 2, lines 3-4.

⁵Advisory Action dated February 2, 2006, page 2, lines 9-10.

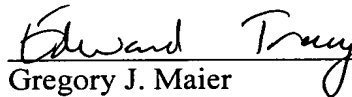
Claim 1. Further, it is respectfully submitted that 'Frequently Asked Questions about XML' does not cure any of the above-noted deficiencies of P '045. Accordingly, it is respectfully submitted that Claim 12 is patentable over P '045 in view of 'Frequently Asked Questions about XML.'

CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Edward Tracy
Registration No. 47,998